

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re

U.S. application of: Yoshikazu IKENOUE, Hideo KUMASHIRO, and
Munehiro NAKATANI
For: IMAGE FORMING APPARATUS AND COPY
MANAGEMENT SYSTEM
U.S. Serial No.: To Be Assigned
Confirmation No. To Be Assigned
Filed: Concurrently
Prior Application:

U.S. Serial No.: 08/911,101

Confirmation No.: 3290

Filed: August 14, 1997

Group Art Unit: 2623

Examiner: Jon Chang

Allowed: September 8, 2003


MAIL STOP PATENT APPLICATION

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

EXPRESS MAIL MAILING LABEL NO: EV 411784693 US DATE OF DEPOSIT: DECEMBER 5, 2003 I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated above and is addressed to MAIL STOP PATENT APPLICATION, Commissioner for Patents, Alexandria, VA 22313-1450. Derrick T. Gordon Name of Person Mailing Paper or Fee  Signature December 5, 2003 Date of Signature
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INFORMATION DISCLOSURE STATEMENT

The above-identified U.S. patent application is a division of co-pending U.S.
Patent Application Serial No. 10/084,708, filed February 21, 2002; which is a division of
co-pending allowed U.S. Patent Application Serial No. 08/911,101 filed August 14,
1997; which is a division of U.S. Patent Application Serial No. 08/893,141, filed July 15,

1997, now U.S. Patent No. 5,987,127; which is a division of U.S. Patent Application Serial No. 08/327,223, filed October 21, 1994, 1994, now U.S. Patent No. 5,671,277; which is a continuation of U.S. Patent Application Serial No. 08/084,408, filed June 29, 1993, abandoned, which claimed priority from Japanese Patent Applications Nos. 4-172617, 4-172621, 4-172659; 4-172672, and 4-172680.

In compliance with the duty of disclosure set forth in 37 C.F.R. § 1.56, Applicants wish to bring the following items to the attention of the Examiner. As each item was cited in a related application, no copy of the documents is enclosed.

No representation is made, and no representation is intended, that more relevant material does not exist, or that the order of presentation of this material in any way reflects its relative pertinence. The references cited below are not intended to constitute an admission of any kind. Specifically, this presentation is not an admission that the items listed below are properly citable against the above-identified application.

The following documents are cited in the specification of the related applications and the present application:

- (1) Watanabe, U.S. Patent No. 4,837,737, issued June 6, 1989;
- (2) Japanese Published Unexamined Patent Application No. (A) 2-052384 (CANON INC), published February 21, 1990;
- (3) Japanese Published Unexamined Patent Application No. (A) 2-111161 (FUJI SHASHIN FILM KABUSHIKI KAISHA), published April 24, 1990;
- (4) Japanese Published Unexamined Patent Application No. (A) 2-120753 (TOSHIBA CORP), published May 8, 1990;
- (5) Japanese Published Unexamined Patent Application No. (A) 2-266759, published October 31, 1990;

- (6) Japanese Published Unexamined Patent Application No. (A) 3-120561 (CANON INC), published May 22, 1991; and
- (7) Yasuhiro Nakamura and Kineo Matsui, "A Unified Coding Method of Image and Text Data Using Three-Level Micro-Patterns", Gazou Denshi Gakkaishi, Vol. 17, No. 1 (1988), pgs. 3-9.

Each of the following documents was cited in at least one of the parent applications:

- (8) Morris et al, U.S. Patent No. 1,002,600, issued September 5, 1911;
- (9) Hembrooke, U.S. Patent No. 3,004,104, issued October 10, 1961;
- (10) Wicker, U.S. Patent No. 3,784,289, issued January 8, 1974;
- (11) Merchant, U.S. Patent No. 4,668,597, issued May 26, 1987;
- (12) Allen, U.S. Patent No. 4,739,377, issued April 19, 1988;
- (13) Tung, U.S. Patent No. 4,847,641, issued July 11, 1989;
- (14) Obata et al, U.S. Patent No. 5,212,558, issued May 18, 1993;
- (15) Suzuki et al, U.S. Patent No. 5,216,724, issued June 1, 1993;
- (16) Earl et al, U.S. Patent No. 5,231,663, issued July 27, 1993;
- (17) Masuzaki et al, U.S. Patent No. 5,235,681, issued August 10, 1993;
- (18) Wang, U.S. Patent No. 5,243,655, issued September 7, 1993;
- (19) Bühn et al, U.S. Patent No. 5,245,655, issued September 14, 1993;
- (20) Funada et al, U.S. Patent No. 5,257,119, issued October 26, 1993;
- (21) Vincett et al, U.S. Patent No. 5,299,026, issued March 29, 1994;

- (22) Tow, U.S. Patent No. 5,315,098, issued May 24, 1994;
- (23) Wang et al, U.S. Patent No. 5,337,361, issued August 9, 1994;
- (24) Spannenburg, U.S. Patent No. 5,374,976, issued December 20, 1994;
- (25) Nishikawa, U.S. Patent No. 5,418,602, issued May 23, 1995;
- (26) Ohmura, U.S. Patent No. 5,424,807, issued June 13, 1995;
- (27) Suzuki et al, U.S. Patent No. 5,426,710, issued June 20, 1995;
- (28) Udagawa et al, U.S. Patent No. 5,481,377, issued January 2, 1996;
- (29) Wang et al, U.S. Patent No. 5,489,158, issued February 6, 1996;
- (30) Hasuo et al, U.S. Patent No. 5,583,614, issued December 10, 1996;
- (31) Uchida et al, U.S. Patent No. 5,640,253, issued June 17, 1997;
- (32) Ikenoue et al, U.S. Patent No. 5,671,277, issued September 23, 1997;
- (34) Powell et al, U.S. Patent No. 5,721,788, issued February 24, 1998;
- (34) Ikenoue et al, U.S. Patent No. 5,987,127, issued November 16, 1999;
- (35) Negishi, U.S. Patent No. 6,166,750, issued December 26, 2000;
- (36) Japanese Patent Laid-Open Publication No. (A) 55-123270, (RICOH CO LTD), published September 22, 1980;
- (37) Japanese Published Unexamined Patent Application No. (A) 61-285578 (HITACHI, LTD.), published December 16, 1986;
- (38) Japanese Published Unexamined Patent Application No. (U) 61-204766 (TOPPAN PRINTING CO LTD), published December 24, 1986;

- (39) Japanese Published Unexamined Patent Application No. (A) 62-111800 (DAINIPPON PRINTING CO LTD), published May 22, 1987;
- (40) Japanese Published Unexamined Patent Application No. (A) 62-256046 (RICOH CO., LTD.), published November 7, 1987;
- (41) Japanese Published Unexamined Patent Application No. (A) 2-096276 (HITACHI LTD), published April 9, 1990;
- (42) Japanese Published Unexamined Patent Application No. (A) 2-161477 (CANON INC), published June 21, 1990;
- (43) Japanese Patent Laid-Open Publication No. (A) 2-284189, (CANON INC), published November 21, 1990;
- (44) Japanese Published Unexamined Patent Application No. (A) 3-256087 (FUJITSU LTD), published November 14, 1991;
- (45) Japanese Published Unexamined Patent Application No. (A) 4-009963 (RICOH CO., LTD.), published January 14, 1992;
- (46) Japanese Published Unexamined Patent Application No. (A) 4-343568 (CANON INC), published November 30, 1992;
- (47) Japanese Published Unexamined Patent Application No. (A) 5-219353 (CANON INC), published August 27, 1993;
- (48) "Unauthorized Copy Prevention", IBM Technical Disclosure Bulletin, June 1975, pgs. 59-60;
- (49) "Document Security System for Copy Machines", IBM Technical Disclosure Bulletin, January 1981, pgs. 3550-3551;

- (50) Hara et al, "An Improved Method of Embedding Data Into Pictures by Modulo Masking", IEEE Transactions on Communications, March 1988, Vol. 36, No. 3, pgs. 315-331;
- (51) Tanaka et al, "Embedding Secret Information Into a Dithered Multi-Level Image", MILCOM '90, IEEE, Vol. 1, pgs. 216-220;
- (52) Komatsu et al., "Authentication System Using Concealed Image in Telematics", Memoirs of the School of Science & Engineering, Waseda University, No. 52, pgs. 45-60, 1988;
- (53) Komatsu et al., "A Proposal on Digital Watermark in Document Image Communication and Its Application to Realizing a Signature", Electronics and Communications in Japan, Part 1, Vol. 73, No. 5, 1990 (translation pgs. 22-33);
- (54) Naohisa Komatsu, "Information Security For Facsimile Communication"; Gazo Denshi Gakkaishi (Journal of the Institute of Picture and Electronics Engineers) Vol. 19, No. 4, April 1990, pgs 229-235 and translation (pgs. 1-12);
- (55) Costas S. Xydeas et al, "Embedding Data Into Pictures By Modulo Masking", IEEE Transactions on Communications, Vol. COM-32, No. 1, January 1984, pgs 56-70; and
- (56) Michio Yamada et al, "A Proposal on Secure Document Image Management Facilities Using Smart Card", Proc. of 1989 Autumn Meeting of the Institute of Electronics, Information and Communication Engineers, SD-2-3, September 1989, pgs 223-224 and translation (3 pgs).

As this Information Disclosure Statement is being filed concurrently with the application, no fee is incurred. However, if it should be determined that a fee is required, please charge any required fee (other than the issue fee) during the pendency of this application to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Please credit any overpayment to Deposit Account No. 18-1260.

Respectfully submitted,



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INFORMATION DISCLOSURE STATEMENT BY APPLICANTS				Complete if Known				
				Application Number	To Be Assigned			
				Filing Date	Concurrently			
				Confirmation No.	To Be Assigned			
				First Inventor	Yoshikazu IKENOUE et al			
Group Art Unit	To Be Assigned							
Examiner Name	To Be Assigned							
Attorney Docket No.	05058/16306							
Sheet	1	of	3					
U.S. PATENT DOCUMENTS								
Examiner Initials	Cite #	DOCUMENT NUMBER	C O D E	PATENTEE	ISSUE DATE (mm/dd/yy)	CLASS	SUB CLASS	Filing Date if Appropriate
	(1)	4,837,737		Watanabe	06/06/89	364	900	
	(8)	1,002,600		Morris et al	09/05/11			
	(9)	3,004,104		Hembroke	10/10/61	179	2	
	(10)	3,784,289		Wicker	01/08/74	350	321	
	(11)	4,668,597		Merchant	05/26/87	430	22	
	(12)	4,739,377		Allen	04/19/88	355	133	
	(13)	4,847,641		Tung	07/11/89	346	154	
	(14)	5,212,558		Obata et al	05/18/93	358	296	
	(15)	5,216,724		Suzuki et al	06/01/93	382	7	
	(16)	5,231,663		Earl et al	07/27/93	380	18	
	(17)	5,235,681		Masuzaki et al	08/10/93	395	164	
	(18)	5,243,655		Wang	09/07/93	380	51	
	(19)	5,245,655		Bühn et al	09/14/93	380	18	
	(20)	5,257,119		Funada et al	10/26/93	358	438	
	(21)	5,299,026		Vincett et al	03/29/94	358	401	
	(22)	5,315,098		Tow	05/24/94	235	494	
	(23)	5,337,361		Wang et al	08/09/94	380	51	
	(24)	5,374,976		Spannenburg	12/20/94	355	201	
	(25)	5,418,602		Nishikawa	05/23/95	355	201	
	(26)	5,424,807		Ohmura	06/13/95	355	201	
	(27)	5,426,710		Suzuki et al	06/20/95	382	135	
	(28)	5,481,377		Udagawa et al	01/02/96	358	501	
	(29)	5,489,158		Wang et al	02/06/96	400	103	
	(30)	5,583,614		Hasuo et al	12/10/96	355	201	
	(31)	5,640,253		Uchida et al	06/17/97	358	501	
	(32)	5,671,277		Ikenoue et al	09/23/97	380	7	
	(33)	5,721,788		Powell et al	02/24/98	382	100	
	(34)	5,987,127		Ikenoue et al	11/16/99	380	7	
	(35)	6,166,750		Negishi	12/26/00	347	131	
FOREIGN PATENT DOCUMENTS								
Examiner Initials		O F F I C E	NUMBER	C O D E	PUBLICATION DATE (mm/dd/yy)	TRANSLATION Yes No		
	(2)	JP	2-052384	A	02/21/90	ABSTRACT ONLY		
	(3)	JP	2-111161	A	04/24/90	X		

INFORMATION DISCLOSURE STATEMENT BY APPLICANTS				Complete if Known		
				Application Number	To Be Assigned	
				Filing Date	Concurrently	
				Confirmation No.	To Be Assigned	
				First Inventor	Yoshikazu IKENOUE et al	
				Group Art Unit	To Be Assigned	
Sheet	2	of	3	Examiner Name	To Be Assigned	
				Attorney Docket No.	05058/16306	
FOREIGN PATENT DOCUMENTS						
Examiner Initials		O F F I C E	NUMBER	C O D E	PUBLICATION DATE (mm/dd/yy)	TRANSLATION Yes No
	(4)	JP	2-120753	A	05/08/90	ABSTRACT ONLY
	(5)	JP	2-266759	A	10/31/90	x
	(6)	JP	3-120561	A	05/22/91	ABSTRACT ONLY
	(36)	JP	55-123270	A	09/22/80	
	(37)	JP	61-285578	A	12/16/86	X
	(38)	JP	61-204766	U	12/24/86	ABSTRACT ONLY
	(39)	JP	62-111800	A	05/22/87	ABSTRACT ONLY
	(40)	JP	62-256046	A	11/07/87	X
	(41)	JP	2-096276	A	04/09/90	ABSTRACT ONLY
	(42)	JP	2-161477	A	06/21/90	ABSTRACT ONLY
	(43)	JP	2-284189	A	11/21/90	ABSTRACT ONLY
	(44)	JP	3-246087	A	11/14/91	
	(45)	JP	4-009963	A	01/14/92	X
	(46)	JP	4-343568	A	11/30/92	ABSTRACT ONLY
	(47)	JP	5-219353	A	08/27/93	ABSTRACT ONLY
OTHER NON PATENT LITERATURE DOCUMENTS						
Examiner Initials		Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published				
	(7)	Yasuhiro Nakamura and Kineo Matsui, "A Unified Coding Method of Image and Text Data Using Three-Level Micro-Patterns", Gazou Denshi Gakkaishi, Vol. 17, No. 1 (1988), pgs. 1-14				
	(48)	"Unauthorized Copy Prevention", IBM Technical Disclosure Bulletin, June 1975, pgs. 59-60				
	(49)	"Document Security System for Copy Machines", IBM Technical Disclosure Bulletin, January 1981, pgs. 3550-3551				
	(50)	Hara et al, "An Improved Method of Embedding Data Into Pictures by Modulo Masking", IEEE Transactions on Communications, March 1988, Vol. 36, No. 3, pgs. 315-331				
	(51)	Tanaka et al, "Embedding Secret Information Into a Dithered Multi-Level Image", MILCOM '90, IEEE, Vol. 1, pgs. 216-220				
	(52)	Komatsu et al, "Authentication System Using Concealed Image in Telematics", Memoirs of the School of Science & Engineering, Waseda University, No. 52, pgs. 45-60, 1988				

Substitute for form 1449A/PTO			Complete if Known		
INFORMATION DISCLOSURE STATEMENT BY APPLICANTS			Application Number	To Be Assigned	
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			First Inventor	Yoshikazu IKENOUE et al	
			Group Art Unit	To Be Assigned	
			Examiner Name	To Be Assigned	
Sheet	2	of	3	Attorney Docket No.	05058/16306
OTHER NON PATENT LITERATURE DOCUMENTS					
Examiner Initials		Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published			
	(53)	Komatsu et al, "A Proposal on Digital Watermark in Document Image Communication and Its Application to Realizing a Signature", Electronics and Communications in Japan, Part 1, Vol. 73, No. 5, 1990 (translation pgs. 22-33)			
	(54)	Naohisa Komatsu, "Information Security For Facsimile Communication", Gazo Denshi Gakkaishi (Journal of the Institute of Picture and Electronics Engineers) Vol. 19, No. 4, April 1990, pgs 229-235 and translation (pgs. 1-12)			
	(55)	Costas S. Xydeas et al, "Embedding Data Into Pictures By Modulo Masking", IEEE Transactions on Communications, Vol. COM-32, No. 1, January 1984, pgs 56-70			
	(56)	Michio Yamada et al, "A Proposal on Secure Document Image Management Facilities Using Smart Card", "Proc. of 1989 Autumn Meeting of the Institute of Electronics, Information and Communication Engineers, SD-2-3, September 1989, pgs 223-224 and translation (3 pgs)			
Examiner Signature			Date Considered		

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with the next communication to applicant.